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PAPER NO. 16

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MAY 29 2007

**OFFICE OF PETITIONS**

In re Patent No. 5,893,087	:	
Issue Date: April 6, 1999	:	
Application No. 08/633,842	:	DECISION ON PETITION
Filed: April 10, 1996	:	UNDER 37 CFR 1.378(b)
Attorney Docket No. P01003US	:	
Patentee(s): Scott Wlaschin, Robert Gordon,	:	
Louise J. Wannier, and Clay Gordon	:	

**CORRECTED DECISION**

The Petition Decision mailed on September 11, 2006 for the above-identified patent is hereby VACATED.

This is a CORRECTED decision replacing the decision mailed on September 11, 2006 on the RENEWED petition under 37 CFR 1.378(b), filed December 5, 2005<sup>1</sup>, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

A first petition to revive under 37 CFR 1.378(b) was filed on August 22, 2005 and was dismissed on November 4, 2005. A renewed petition<sup>2</sup> was filed on December 5, 2005.

The petition is **DISMISSED**.

<sup>1</sup> The decision mailed on September 11, 2006 stated that it is in response to the petition filed on January 9, 2006. The date of January 9, 2006 is in error and it should have been stated as December 5, 2005.

<sup>2</sup> Petitioner submitted information supporting the renewed petition for three patents (P.N. 5,893,087, 5,850,522, and 5,790,848) in one combined document. This is not acceptable. 37 CFR 1.4(b) states that "each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical." The renewed petition dated December 5, 2005 has been filed in the first listed patent number 5,893,087. If petitioner wishes to renew the petition in the other two patents, then petitioner must file a separate copy for each appropriate file.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued on April 6, 1999. The first maintenance fee could have been paid from April 6, 2002, through October 7, 2002, or with a surcharge during the period from October 8, 2002 through April 7, 2003. Accordingly, the patent expired at midnight April 6, 2003, for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

**This renewed petition still lacks item (1) above.**

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Petitioner states that the delay in payment of the first maintenance fee was unavoidable due to the bankruptcy of Enfish Corporation in October 2004 and the petitioner's subsequent diagnosis and treatment for cancer during various times from May 2003 thru February 2005.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or

greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

In essence, petitioner must show that she was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment.

Petitioner states in the renewed petition filed on December 5, 2005 that the Enfish Inc.'s CFO Mark Bucklin and the company's patent attorneys Morrison and Foerster (Morrison) were the responsible party for calendaring and tracking the maintenance fee payments and making the required payment. Around mid-2002, Morrison stopped working for Enfish and terminated all communications due to unpaid bills amounting to approximately \$50,000. Enfish became insolvent around August 2002 and completed Chapter 7 bankruptcy around October 2004.

The start of the window for making the first maintenance fee payment was April 8, 2002. However, the record states that Morrison terminated their relationship around mid-2002 which was after the start of the period when the first maintenance fee could have been paid. In other words, before the start of the maintenance fee payment window (April 8, 2002), Morrison and Enfish still had a working relationship, therefore one would assume that if Morrison was the party responsible for tracking the payment dates, they would have informed Enfish prior to April 8, 2002 that the maintenance fees would have been due. Therefore if Morrison and/or Enfish's CFO were the responsible party for calendaring the appropriate maintenance fee payments, petitioner should submit any documentary proof of the maintenance fee payment tracking system used by Morrison and/or the Enfish CFO along with evidence of the steps in place for ensuring payment of the maintenance fee was timely.

While the petition states that petitioner relied on Enfish's CFO and Morrison for tracking and making the maintenance fee payment, Petitioner also clearly stated the Enfish along with petitioner did NOT have knowledge that maintenance fees were due<sup>2</sup>. **Even assuming that Morrison properly calendared the required maintenance fee due dates, there is no evidence on record that Enfish or petitioner had continued to track or calendar the required maintenance fees payment or had steps in place to ensure the timely payment of the first maintenance fee after Morrison terminated their relationship in mid-2002.** Therefore, the record shows that from mid-2002 and during the period when the maintenance fee could have been paid from April 8, 2002 thru April 7, 2003, petitioner had no steps in place and did not take any reasonable care to ensure that the maintenance fee would be timely paid to prevent expiration of the patent. Since no steps were taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

While the evidence does show that Enfish had financial difficulties during the time the maintenance fee payments could have been paid, petitioner admits to the total lack of knowledge of having to pay the maintenance fee as stated in the record<sup>3</sup> and as evidenced by the fact that the maintenance fee payment was not included as a necessary or priority payment in the company's bankruptcy statements.

While it is not clear on the record the exact time frame and circumstances that petitioner first realized that the patent expired, petitioner stated she did not review the patent until *after* the completion of the main part of her medical treatments and *after* the completion of the Enfish bankruptcy because she was unaware that the patent had lapsed<sup>4</sup>.

Unfortunately, any delay resulting from the actions or inactions of the patentee is binding upon petitioners as the successors in title. See Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). While petitioner gained ownership of this patent on June 2004, such merely gave petitioners standing to file the instant petition on or after that date. The delay resulting from their lack of knowledge of the need to pay maintenance fees does not excuse their delay. See Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd*, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992). Lastly, that one may have subsequently exercised diligence after their assumption of title and belated awareness of the need to pay the fee does not convert the preceding delay into unavoidable delay. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989).

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<sup>2</sup> "If the company had known that maintenance payments were due subsequent to this time [mid-2002], the company would have included these payments in the priority amounts that is made during the workout and transition to bankruptcy." From first paragraph on page 4 of the renewed petition dated December 5, 2005.

<sup>3</sup> "If I, as incorporator and responsible party for LJM Software had known of the unintentional reinstatement period and the nonpayment of the maintenance fees, they would have been paid." From second paragraph on page 4 of the renewed petition dated December 5, 2005.

<sup>4</sup> "During this time [treatment for cancer May 2003], I was completely unaware that the patent payments had lapsed because I received no mailing from the patent offices, the Enfish attorneys ceased correspondence due to their being owed money by the company and it was not until subsequent to the completion of the main part of the treatments and the completion of the Enfish bankruptcy that I reviewed the patents and discovered that they were in arrears." From second paragraph on page 6 of the renewed petition dated December 5, 2005.

Assuming that petitioner first discovered the expired patent in June 2004, when the petitioner's company LJM Software acquired the patent rights from Enfish, or even in October 2004 after the completion of the Enfish bankruptcy, no action was taken with regard to the maintenance fee or the lapsed patent until March 15, 2005 when petitioner meet with Mr. Kevin Spivak of Morrison about reinstating the expired patents. Petitioner submitted a document (attachment F) provided by Morrison to her which indicated an abandonment date of May 7, 2003 which she relied upon as the date from which the patent may be reinstated. A review of document F indicated no inaccuracies with regard to the data. While May 7, 2003 is listed as the abandonment date for the application, there is no correlation between the abandonment date and the date from which to reinstate the patent.

Petitioner credits the delay (from mid-2004 until August 22, 2005) in filing the petition promptly after being aware or notified of the expiration of the patent was due to her medical surgeries and her recuperation. While the record states that petitioner underwent numerous medical treatments, it did not appear to interfere with petitioner's other business dealings. The record shows that during the periods between the surgeries and/or treatments, petitioner was able to complete her other business affairs including having LJM Software legally acquire the assets of Enfish in June 4, 2004 and the work leading to the completion of the Enfish bankruptcy from August 2002 thru October 20, 2004. Therefore, evidence of record shows that petitioner was able to handle other business affairs during the periods between her stated surgeries which coincide with the time period when the delayed maintenance fee payment could have been made.

As to the health problems, petitioner should note that under the circumstances of this case, she will have to provide documents from licensed health care providers, demonstrating the nature and extent of petitioner's incapacitation, in such a manner that petitioner was, from the date of expiry until the filing of the initial petition on August 22, 2005, "unavoidably" prevented from taking any earlier action with respect to this patent. Additionally, petitioner must state how she managed to conduct her daily personal and business affairs, including scheduling and settlement of short and long term debts and business obligations, bills, rent or mortgage payments, income taxes etc., during the time in question. Petitioner must demonstrate that the health problems were such as to cause the payment of the maintenance fee to have been unavoidably delayed.

Furthermore, petitioner admits that while she was concerned with recovering her health during the period when the patent expired, she was also unaware that the patent payments had lapsed because she received no communications regarding the maintenance fee from the USPTO or from Morrison. In order words, petitioner had no steps in place for paying the maintenance fees from mid-2002 until the date of the first petition on August 22, 2005. **Put otherwise, the issues of petitioner's health and financial problems are immaterial in the absence of a showing of reasonable care in dealing with one's most important business. Therefore petitioner has not shown that the delay was unavoidable.** The showing of record is that the delay in taking action in the above-identified application was the result of petitioner's preoccupation with other matters. Petitioner's preoccupation with other matters which took precedence over the above-identified application does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

The record shows that Enfish and petitioner had a portfolio of other patents. Patent numbers 5,893,087, 5,850,522, and 5,790,848 had expired due to non-payment of the maintenance fee and contained petitions to reinstate under 37 CFR 1.378(c). However, patent number 6,182,121 had a maintenance fee payment due around the same time as the other aforementioned expired patents, but was timely paid on July 1, 2004. This fee was timely paid as during the period after petitioner's chemotherapy treatment ending in January 2004, after petitioner acquired Enfish's assets on June 4, 2004, and prior to petitioner's surgery in August 2004. Therefore it is unclear how the reasons given for the unavoidable delay of the maintenance fee payment and expiration of the three aforementioned patents did not also affect the timely payment of the maintenance fee for patent number 6,182,121. If petitioner's health and financial problems affected the timely payment of the maintenance fees of the three aforementioned Enfish patents, what were the circumstances that lead to the timely payment of the maintenance fee for patent number 6,182,121?

Since the petition decision dated September 11, 2006 has been vacated and in view of the present corrected decision, the status of this patent is EXPIRED. If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** Petitioner is reminded that any renewed petition and the required fee(s) should be filed separately for each patent desiring reconsideration.

The combined payment of \$1,200 on August 25, 2005 for renewing the petitions in patents 5,893,087, 5,850,522, and 5,790,848 was credited in the instant patent and will be refunded back to petitioner's credit card in view of the vacated decision. An extra payment of \$1,150 was found to be charged in the instant patent on August 25, 2005 and will be refunded back to petitioner's credit card. The 7 ½ year maintenance fee paid on October 6, 2006 will be refunded and credited back to the corresponding deposit account because the patent expired for failure to timely pay the 3 ½ year maintenance fee.

Petitioner is reminded that pursuant to 37 CFR 1.2 all business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Amelia Au at (571) 272-7414.



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